



PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 10/034,720 Examiner: Charles E. Phillips
Inventor: Earl J. Braxton Group Art Unit: 3751
Filing Date: December 28, 2001
Title: Portable Toilet Shelter Having Improved Stackability

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. §121

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In the Office Action of October 10, 2002, Paper No. 2, the Examiner set forth a restriction requirement under 35 U.S.C. §121 between Claims 1 through 18 as Group I, drawn to a portable toilet shelter, classified in class 4, subclass 449, and Claims 19-20, as Group II, drawn to a toilet unit, classified in class 4, subclass 483. Applicant hereby traverses the restriction requirement under the authority of 37 CFR §1.143. Notwithstanding the traversal, Applicant, as required in the Office Action, hereby provisionally elects the claims of Group I, with traverse, to further the prosecution of this application. Applicant's attorney, however, respectfully submits that the requirement for restriction is improper, as a matter of law and fact, for the following reasons.

It is respectfully suggested that the Examiner's classification of Groups I and II are incorrect. Subclass 449 applies to subject matter having means for receiving human waste material wherein a flush liquid is not used to assist the removal of the material from the means. It is readily apparent that the claims of Group I are drawn to a

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shelter for a portable toilet and do not cover means for receiving human waste material wherein a flush liquid is not used to assist the removal of the material. As the Examiner does not provide any support whatsoever for the conclusion that the claims of Group I apply to subject matter having means for receiving human waste material wherein a flush liquid is not used, and in fact Applicant's specification makes clear that these claims do not apply to such subject matter, it is suggested that the Examiner's restriction requirement is improper.

Subclass 483 is indented under subclass 479, and subclass 479 is further indented under subclass 449 such that subclass 483 also applies to subject matter having means for receiving human waste material wherein a flush liquid is not used. The claims of Group II drawn to a toilet unit do not apply exclusively to subject matter having means for receiving human waste material wherein a flush liquid is not used, nor does the Examiner provide support for such a classification. The improper classification of the Group II claims is even more apparent in light of the following example provided in the description of subclass 449 which indirectly applies to subclass 483: "A bedpan may be cleaned by using water from a supply. If liquid handling means is used to flush the bedpan, the patents will be placed in subclasses for a liquid flush closet." It is unclear why the Examiner concluded that the toilet unit of Group II applies exclusively to subject matter wherein a flush liquid is not used, but to assume that the toilet unit is not even adapted for cleaning with an external water supply such as the bedpan in the above cited example is obviously incorrect.

As the MPEP interpretation of 35 U.S.C. §121 relies in part on the classification of the claims, the Examiner's improper classification thereof undermines

the entire analysis. Furthermore, it appears that the Examiner does not understand Applicant's invention and/or the classification system, and any subsequent patent search limited to prior art patents having means for receiving human waste material wherein a flush liquid is not used cannot support a proper examination of Applicant's invention. It is therefore requested that the Examiner withdraw the restriction requirement and reclassify Applicant's claims.

The Examiner's restriction concludes that the claims of Group I and Group II are related as combination and sub-combination without providing any support for such a conclusion. It is respectfully suggested that the claims of Group I and the claims of Group II are clearly not related as combination and sub-combination, respectively. MPEP §806.05(a) provides in part "A combination is an organization of which a sub-combination or element is a part." While dependent Claims 5, 10, and 15 are drawn to an embodiment of the shelter having a commode, the remaining Claims 1-18 are drawn exclusively to the shelter. The toilet unit of Group II is arguably part of the embodiment claimed in dependent Claims 5, 10 and 15, but is not otherwise part of the claimed shelter to which Group I is drawn.

35 U.S.C. §121 provides: "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." (Emphasis added). 37 CFR §1.141 similarly provides: "Two or more independent and distinct inventions may not be claimed in one national application..." (Emphasis added). It is respectfully suggested that the interpretation of the law cited hereinabove by the Commissioner in MPEP §802.01 is without authority.

The powers granted to the United States Patent and Trademark Office under 35 U.S.C. §2 for the purpose of establishing rules and regulations are clearly limited by and therefore cannot be inconsistent with the law made in accordance with section 553 of title 5, United States Code, 35 U.S.C. §2(b)(2)(B). MPEP §802.01 effectively interprets the clear and unambiguous language of 35 U.S.C. §121 stating “independent and distinct” as “independent or distinct”, which is plainly inconsistent therewith. As the Commissioner does not provide statutory support for his attempt to modify the plain meaning of 35 U.S.C. §121, it is respectfully suggested such is without authority.

It is respectfully submitted that it will not be possible to make a showing that the invention of the Group I claims, on the one hand, and the invention of the Group II claim, on the other hand, are, in fact, "independent" of one another, as those terms are defined in MPEP §802.01 and §806.04. Specifically, MPEP §806.04 addresses the term “independent” for two combinations of an invention. MPEP §806.04(A) defines “independent” as “[t]wo different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects...,” and cites as an example “An article of apparel such as a shoe, and a locomotive bearing....” In contrast, the invention of Groups I, and II do not meet this definition of independent, nor do they even come close to comparison with the example given in the MPEP. Here, the combinations claimed in Groups I and II are both disclosed and intended to be used together. As the Examiner has not shown that the claims of Group I and Group II are both “independent and distinct” as required by 35 U.S.C. §121, it is respectfully suggested that the requirement for restriction is improper and should be withdrawn.

Assuming arguendo that the claims of Groups I and II are independent, it is respectfully suggested that the Examiner improperly applies MPEP §806.05(c), and that Groups I and II are not Distinct. MPEP §806.05(c) provides in relevant part “The inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations.” Although not identified as specifically addressing the aforementioned requirement for distinctness, the Examiner appears to be addressing elements (A) and (B) by stating: “In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the tank portion is not required. The subcombination has separate utility such as with or without a shelter.” (Page 2, lines 9-12 of the subject Office Action). The Examiner’s analysis under MPEP §806.05(c) is improper for the following reasons.

The Examiner’s analysis under element A of MPEP §806.05(c) assumes that the claims of Groups I and II are properly related as combination-subcombination. The Examiner’s conclusion that the claims of Group I do not require the particulars of the claims of Group II because the tank portion is not required is not indicative of distinctness but rather that Groups I and II are not properly related as combination-subcombination, as shown hereinabove. In other words, analysis under MPEP §806.05(c) is only appropriate where the Groups are properly classified as combination-subcombination, and conversely, analysis under MPEP §806.05(c) of Groups improperly classified as combination-subcombination is inherently flawed.

Regarding the analysis of Groups I and II under element (B) of MPEP §806.05(c), the Examiner's conclusion that the toilet unit adapted for use with a portable toilet shelter as claimed in Group II has separate utility such as with or without a shelter is completely unrealistic. The Examiner's assertion that the toilet shelter as claimed in Group II has separate utility without a shelter is clearly contrary to the preamble of independent Claim 19 that specifies the toilet unit is adapted for use within a portable toilet shelter. Furthermore, it seems highly unlikely that a portable toilet without the shelter for which it is adapted would have any utility whatsoever in that a prospective user would be completely exposed during such usage.

MPEP §803 provides in part "If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits..." (emphasis added). Additionally, MPEP §806.05(c) requires that reasons for insisting on a restriction be demonstrated. Although not identified as specifically addressing MPEP §803 and/or MPEP §806.05(c), the Examiner appears to be addressing such requirements by stating that the search required for Group II is not required for Group I. The Examiner does not, however, indicate that the search required for Group I is required for Group II in that, as previously shown, subclass 483 is indented under subclass 479, and subclass 479 is indented under subclass 449. Accordingly, there is no additional burden whatsoever in that a patent search for the claims of Group II will eventually be carried out, whether in the present case or in a continuation thereof, and such patent search will encompass the search required for the claims of Group I. It is therefore suggested that the Examiner withdraw the requirement for restriction and

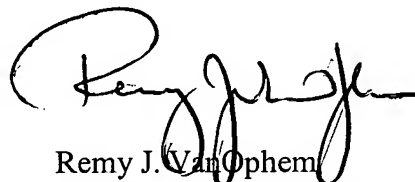
thereafter minimize any additional burden by beginning the patent search with respect to the Claims of Group II.

As the Examiner has not supported his contention that the claims of Group I and Group II are related as combination and sub-combination, has made no showing that Groups I and II are independent, and improperly concluded that Groups I and II are distinct, Applicant respectfully requests reconsideration and withdrawal of the requirement for restriction. Favorable action on all claims now pending in this application is likewise respectfully requested.

If the Examiner has any questions with respect to any matter now of record, Applicants' attorney may be reached at (248) 362-1210.

Respectfully submitted,

VANOPHEM & VANOPHEM, P.C.



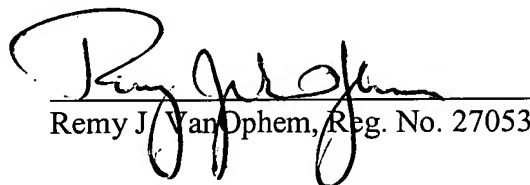
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on November 12, 2002.

Date: November 12, 2002



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